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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,223	11/18/2003	Takahiro Nakajima	11197/5	3150

23838 7590 10/31/2006

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WASHINGTON, DC 20005

EXAMINER

PASTERCZYK, JAMES W

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/830,223

Applicant(s)

NAKAJIMA ET AL.

Examiner

J. Pasterczyk

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 78-125 is/are pending in the application.
- 4a) Of the above claim(s) 119-124 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 78-118 and 125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 78-125 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

Art Unit: 1755

1. This Office action is in response to the RCE filed 9/29/06. Claims 78-125 are pending in the present application; claims 119-124 stand withdrawn to a non-elected invention due to an earlier restriction requirement.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 78-118 and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu, U.S. Statutory Invention Registration H766 (hereafter referred to as Yu).

Yu discloses the invention substantially as claimed (col. 2, l. 34 to col. 3, l. 35; col. 3, l. 67 to col. 4, l. 20; col. 4, l. 45-60; col. 5, l. 21 to col. 6, l. 8; col. 7, l. 7-62). Especially note the catalyst used in col. 5, l. 26 to col. 6, l. 2, which discloses that a mixture of a metal compound and a phenol may be used as the catalyst, the phenol corresponding to present formula 1 of claim 125.

Yu lacks the specifics of the presently claimed process performed with its disclosed catalyst, especially the particular starting materials which may be polymerized with its catalyst.

However, Yu teaches that these starting materials may be polymerized with another disclosed catalyst similar to that of the present claims.

It would have been obvious to one of ordinary skill in the art to apply that skill to the disclosure of Yu with a reasonable expectation of obtaining a highly-useful process for making a polyester with the expected benefit of the process not requiring metals conventionally used in polyester production.

4. Applicant's arguments filed 9/29/06 have been fully considered but they are not persuasive.

Applicants first argue that Yu lacks disclosure of the catalyst of their claimed process, specifically that it lacks the phenoxy compound of formula 1 in claim 125. However, this compound is found as a solvent in Yu, and it is conventionally known that solvating a reagent, here the metal containing compound of the prior art, increases its reactivity, hence it could be reasonably concluded that the organic compound of Yu is an integral component of its catalyst composition.

Applicants then argue that Yu lacks the particular starting materials of the present claims in combination with applicants's catalyst. However, the catalyst recited in the present claims is conventional, and absent controlling case law, it would have been a conventional modification to use this catalyst in a prior art esterification process, the process also found in the cited prior art.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1755

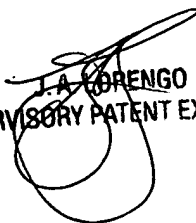
system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Pasterczyk

AU 1755

10/20/06



J. A. LORENGO  
SUPERVISORY PATENT EXAMINER